



## REMARKS

Claims 1-28 remain in the application for further prosecution. Claims 1, 6, 14 and 21 have been amended. Submitted herewith is a clean set of pending claims.

### Information Disclosure Statement

The Examiner only partially initialed the Form PTO-1449 returned with the Office Action. References B1 and B2 were not initialed. The Applicants respectfully request that the Examiner initial these two references and return a fully initialed Form PTO-1449 with the next correspondence.

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### Claim Rejections - 35 U.S.C. § 112

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Claim 6 was rejected due to insufficient antecedent basis for the limitation "the virtual image." Claim 6 has been amended to depend from claim 5, instead of claim 1, so that there should now be sufficient antecedent basis for the limitation "the virtual image."

### Claim Rejections - 35 U.S.C. §§ 102, 103

Claims 1-3, 10, 11, 14, 15, 17, 18, 21, 25 and 26 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,718,672 to Okada ("Okada"). Claims 4-9, 12, 13, 16, 19, 20, 22-24, 27 and 28 were rejected under 35 U.S.C. 103(a) as being unpatentable over Okada in view of U.S. Patent No. 6,368,216 to Hedrick et al.

The Applicants appreciate the telephone interview afforded by Examiner Mendiratta on August 14, 2002. During that interview, the Applicants explained the differences between the claims and Okada. The claims require a video image provided by a video display and superimposed upon the reels. In contrast, Okada merely discloses a liquid crystal panel with nine rectangular sub-sections. *See* FIG. 8. Each sub-section is only capable of two states: (1) a light transmitting state, and (2) a light shielding state. *See* column 5, lines 58-68. The liquid crystal

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panel cannot display a video image. Due to the differences between the claims and Okada, the Examiner agreed that the above-noted prior art rejections would be withdrawn. Further, to clarify the intended meaning of "superimposed," the Applicants agreed to amend the claims to change "superimposed" to --overlying--.

During the interview, the Examiner raised the prospect of a possible § 103 rejection based on U.S. Patent No. 6,036,188 to Gomez et al. ("Gomez"). The Applicants respectfully submit that the claims are patentable over Gomez, taken alone or modified in view of other prior art. First, the claims recite a reel spinning slot machine. In contrast, Gomez discloses a pinball game. Second, the claims recite a plurality of mechanical rotatable reels that, in response to a wager, are rotated and stopped to randomly place symbols on the reels in visual association with a display area. In contrast, Gomez discloses a pinball playfield for supporting a game piece (e.g., rolling ball) and play features. The pinball playfield is fundamentally different from the claimed mechanical slot reels.

Third, to further differentiate the claims from Gomez, the claims have been amended to relate the video image to the underlying mechanical reels. The claims now require that *the video image interacts with the symbols on the reels*. In contrast, a fundamental objective of Gomez is to create interaction between a rolling pinball of a pinball game and a video image.

Amusement games such as pinball games and video games are often found together in arcades and other gaming establishments. The designers of these games strive to constantly provide innovations to continue to attract interest, both for attracting new players and retaining the interest of present players . . .

[G]enerally speaking, video games have heretofore not provided an opportunity of using a playfield with a rolling ball and other mechanical or electromechanical elements with which the ball interacts in the playfield. On the other hand, pinball games have not heretofore provided the range and complexity of changeable visual effects or displays comparable with those available in video games. Moreover, the play action in pinball games has heretofore been restricted to

interaction of the rolling ball with various playfield devices or play features in the playfield. That is, there has been no interaction of the ball with video generated images or features. Column 1, lines 13-18 and 42-54.

The pinball game is a key component of Gomez. In fact, Gomez is entitled "Amusement Game With Pinball Type Playfield And Virtual Video Images." Thus, it would not have been obvious to modify Gomez to replace the pinball game (or its components) with the mechanical reels of a slot machine. Gomez is solely concerned with interaction between a pinball game and a video image. At column 7, lines 54-57, Gomez suggests that "[t]he *playfield* devices may include various devices for guiding or otherwise interacting with the ball, as well as various physical objects or figures upon which or in connection with the virtual video images may be projected." (Emphasis added). Even in this example, however, Gomez is merely suggesting that the devices on a pinball playfield may include various objects and figures. Gomez does not contemplate using the mechanical reels of a slot machine as a playfield device. It is the Applicants, not Gomez, that teach a slot machine having mechanical reels and a video image overlaying the reels and interacting with symbols on the reels.

The mere fact that the prior art is capable of being modified is not sufficient by itself to establish a *prima facie* case of obviousness. The prior art must suggest the desirability of the claimed invention. If the proposed modification would render the prior art unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. Similarly, if the proposed modification would change the principle of operation of the prior art, then the teachings of the prior art are not sufficient to render the claims *prima facie* obvious. See MPEP 2143.01.

Here, Gomez is focused entirely on interaction between a pinball game and a video image. *If Gomez were modified to replace the pinball game (or its components) with the*

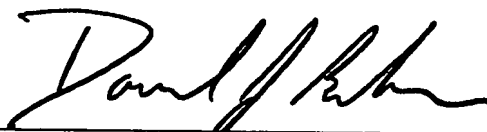
*mechanical reels of a slot machine, the modification would undermine Gomez's intended purpose and change Gomez's principle of operation.* An ordinary artisan would not be motivated to make such a modification.

#### **Conclusion**

The Applicants believe the claims are in condition for allowance, and action towards that end is earnestly solicited.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicants' undersigned attorney at the number indicated.

Respectfully submitted,



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Daniel J. Burnham  
Reg. No. 39,618  
Jenkins & Gilchrist  
225 West Washington Street, Suite 2600  
Chicago, IL 60606-3418  
(312) 425-3900  
Attorney for Applicants

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